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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,192	01/13/2000	JACKI MULLER	81000.3000	6962

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EXAMINER	
PRYOR, ALTON NATHANIEL	
ART UNIT	**PAPER NUMBER**
1616	

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/403,192	Applicant(s) Muller et al
	Examiner Alton Pryor	Art Unit 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *May 25, 2001* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *14-32* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *14-32* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Claim Rejection under 35 U.S.C. 112, 1st paragraph

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for urea derivatives specified in the specification, does not reasonably provide enablement for urea derivatives not named in the specification. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. Examiner suggests that applicant define urea derivatives in Markusk language.

Claim Rejection under 35 U.S.C. 112, 2nd paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The term "derivative" in claim 14 line 4 is a relative term which renders the claim indefinite. The term "derivative" is not defined by the claim, the specification does not provide a

standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. See Examiner's suggestion in 35 U.S.C. 112, 1st paragraph rejection above.

Claim Rejections under 35 U.S.C. 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14-19,23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wieschollek et al (GB 2 245 494; 1/8/92) on record.

Wieschollek et al discloses a wettable powder and wettable granule herbicidal composition comprising metamitron, ethofumesate, phenmedipham and desmedipham as the active herbicides. See abstract, page 1 lines 1-7, page 2 lines 18-27. The reference discloses a number of equivalent carries and emulsifiers that may be a part of the herbicide composition including the carrier, silicic acid and emulsifier, silicone surfactant. See page 6 lines 10-25. The reference also suggests the inclusion of the dispersing agent, lignin sulphonate and customary auxiliaries such as wetting agents in the herbicide composition. See abstract, page 7 lines 5-16, page 11 lines 2-12. The prior art references discloses that the composition is prepared by using an air-jet mill to mix and grind the ingredients of the composition into granules with particle size ranging from 200-1500 um. The reference does not disclose an Example composition comprising

all of the ingredients above, the instant percent ranges of adsorbent, herbicide and surfactant and fineness of 0.5 to 20 um for the composition. However, since the prior art discloses a number of equivalent herbicides and carriers including those above, it would have been obvious to one having ordinary skill at the time the invention was made to choose the prior art herbicides and carrier to make the instant composition. One would have been motivated to do this because the substitution of equivalent compounds in a composition should result in compositions having a similar effect. One having ordinary skill in the art the time the invention was made would have been expected to determine the optimum % ranges and particle size (fineness) of the prior art composition through routine experimentation. The optimum ranges/particle size may have fallen within the instant broad ranges. One would have been motivated to do this in order to develop a composition that would have been most effective in controlling weeds in crop. **In the absence of unexpected data the form of the composition whether it be a suspension or granule has no patentable weight. In a claim to a composition, a statement to the function or benefit of the composition's parts has no patentable significance.**

6. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wieschollek et al as applied to claims 14-19,23-32 above, and further in view of CIBA-GEIGY (WO 95/18531; 7/13/95) on record.

7. See 103(a) rejection for claims 14-19,23-32 above. Wieschollek et al teach all that is recited in claim 4 except for the herbicide composition comprising tridecanol ethoxylate. However, CIBA-GEIGY discloses a herbicidal composition comprising isotridecanol. See page

10 line 34 - page 12 line 17. The composition exists as a wettable powder and is used to control weed growth in crop plants. See abstract, See page 10 line 34 - page 12 line 17. One having ordinary skill in the art at the time the invention was made would have been expected to add the isotridecanol ethoxylate taught by CIBA to the composition taught by Wieschollek et al. One would have been motivated to do this so that high biological activity is achieved with the herbicide formulation at low rates of application. **In the absence of unexpected data the form of the composition whether it be a suspension or granule has no patentable weight. In a claim to a composition, a statement to the function or benefit of the composition's parts has no patentable significance. There exist ample motivation to combine the composition of Wieschollek with the composition of CIBA since both references teach herbicidal compositions.**

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Alton Pryor

Patent Examiner, AU 1616

8/20/01